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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,217	07/08/2003	John T. Kaim	68943	9766

7590 04/06/2004

Cooper & Dunham LLP
1185 Avenue of the Americas
New York, NY 10036

EXAMINER

BRITTAIN, JAMES R

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/616,217

Applicant(s)

KAIM, JOHN T.

Examiner

James R. Brittain

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-16 is/are allowed.
- 6) ☒ Claim(s) 1-5, 7 and 8 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 07082003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3 and 5 are rejected under 35 U.S.C. §102(b) as being clearly anticipated by Tate (US 3924307).

Tate (figures 2, 3) teaches a device for binding sheet in the form of a print comprising a rigid frame 5 including a base surface 7; a first lip defining aperture 10 formed on the rigid frame; a second lip formed on the rigid frame, the second lip including a first set of teeth 14 and a first gap 19 in the first set of teeth; and flexible arcuate spring member 9 having first and second ends, the spring member including a second set of teeth 13, 20 formed at the second end of the spring member and a second gap formed in the second set of teeth, wherein the first end 11, 12 of the spring member is attached to the first lip, and the spring member is placed in a closed position by maneuvering the spring member to guide one 13 of the teeth in the second set through the first gap 19 and to align the second set of teeth with the first set-of teeth, respectively by sliding the spring member 9 in the direction 17. In regard to claim 3, the spring member 9 is slidably integrated with the first lip defining the aperture 10. As to claim 5, the teeth 16 extend out of the arcuate surface of the spring 9 and thereby define two recesses between the adjacent teeth 16 that are each inherently capable of holding a non-planar object.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 4, 7 and 8 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tate (US 3924307) in view of Van Buren (US 1869032).

Tate (figures 2, 3) teaches a device for binding sheet in the form of a print comprising a rigid frame 5 including a base surface 7; a first lip defining aperture 10 formed on the rigid frame; a second lip formed on the rigid frame, the second lip including a first set of teeth 14 and a first gap 19 in the first set of teeth; and flexible arcuate spring member 9 having first and second ends, the spring member including a second set of teeth 13, 20 formed at the second end of the spring member and a second gap formed in the second set of teeth, wherein the first end 11, 12 of the spring member is attached to the first lip, and the spring member is placed in a closed position by maneuvering the spring member to guide one 13 of the teeth in the second set through the first gap 19 and to align the second set of teeth with the first set-of teeth, respectively by sliding the spring member 9 in the direction 17. The difference is that the first end of the spring is slidably attached to the first lip rather than being rotatably attached. However, Van Buren (figures 1, 3, 4) teaches that it is desirable to detachably secure the first end 25 of the spring 24 to the first lip 21 so that it can swing laterally over retaining ridges 22 formed at the exterior edges of the first 21 and second 20 lips (page 1, lines 91-99). This permits complete removal and reassembly as desired. As it would be advantageous to provide the device of Tate with a completely removable connection of the spring so as to permit easy assembly, it would

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have been obvious to modify the device of Tate as suggested by Van Buren (figures 1, 3, 4) teaching that it is desirable to detachably secure the first end 25 of the spring 24 to the first lip 21 so that it can swing laterally over retaining ridges 22 formed at the exterior edges of the first 21 and second 20 lips (page 1, lines 91-99). Applicant is reminded that "[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom." *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). As to claim 7, the difference relative to Tate is that the device is used to secure a print and lacks a cover. However, Van Buren (figure 1) teaches that it is conventional to provide covers to binding devices so as to provide added protection to the held sheets when portable or stored. As it would be advantageous to provide added protection to the sheets secured by the device of Tate when the device is often hand carried or placed in storage, it would have been obvious to modify the device of Tate so as to have a cover as taught by Van Buren to be desirable for portability and storage.

Allowable Subject Matter

Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 9-16 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

While Tate (US 3924307) teaches a device for binding sheet in the form of a print comprising a rigid frame 5 including a base surface 7; a first lip defining aperture 10 formed on the rigid

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frame; a second lip formed on the rigid frame, the second lip including a first set of teeth 14 and a first gap 19 in the first set of teeth; and flexible arcuate spring member 9 having first and second ends, the spring member including a second set of teeth 13, 20 formed at the second end of the spring member and a second gap formed in the second set of teeth, wherein the first end 11, 12 of the spring member is attached to the first lip, and the spring member is placed in a closed position by maneuvering the spring member to guide one 13 of the teeth in the second set through the first gap 19 and to align the second set of teeth with the first set-of teeth, respectively by sliding the spring member 9 in the direction 17, there is no suggestion to modify Tate so that there is an adjustable spacer block positioned on the spring member so that material is held between the spacer block and the base surface when the spring member is in the closed position.

Conclusion

The patents of Van Buren (US 1726558, figures 1, 3; US 2234294, figure 1) and Kuroda (US 4991269, figure 4) teach pertinent clamping device structure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James R. Brittain whose telephone number is 703-308-2222. The examiner can normally be reached on M, W & F 5:30-1:30, T 5:30-2:00 & TH 5:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



James R. Brittain
Primary Examiner
Art Unit 3677

JRB